

REMARKS/ARGUMENTS

As a preliminary matter, Applicant wishes to thank the Examiner for the courtesy he extended to the Applicant's attorney during their telephone conversations.

The specification is amended to correct minor typographical errors. Specifically, the paragraph beginning at line 32 on page 16 is amended to change "pari" to "pair" while the paragraph beginning at line 18 on page 17 is amended to change "paris" to "pairs". No new matter is added.

The Office Action provides that the "oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required."¹ Attached hereto as Exhibit A is a new declaration executed by Pamela Mahany, the widow of the sole inventor Ronald Mahany and executor of Mr. Mahany's estate. As such, Applicant has overcome the Office's objection to the oath or declaration.

The Office Action provides that the disclosure is objected to because "the appendices D3, D4, D5, G, E, H are not mentioned in the present specification (only Appendices A, B, C, D1, D2 and F are mentioned in the present specification)."² This objection is incorrect, as several of the identified appendices are in fact mentioned in the present specification. See, e.g., page 44 of the specification as filed, which identifies both appendices D5 and G. Regardless Applicant submits that appendices D3, D4, D5, G, E, H are mentioned in one or more of the applications cited in the priority chain (See, e.g., Application Serial No. 08/551,442), which are incorporated by reference into the present application.

The Office Action provides that the first two pages of the specification are objected to. Specifically, the Office Action provides that:

the newly-added first two pages of the present specification are objected to under 35 U.S.C. 132 because it introduces new matter into the

¹ Office Action, ¶ 2, lines 1-3.

² Office Action, ¶ 3, lines 1-3.

disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the "incorporated by reference" in the last two paragraphs on page 2 is not supported in the original specification.³

Applicant disagrees that the subject paragraphs add new matter. A careful review of the specification reveals that a majority of the information incorporated by reference includes applications from which the subject application claims priority or are incorporated into the subject application in subsequent pages thereof. As such, the subject paragraphs do not appear to include new matter.

Further, 35 U.S.C. 132 does not prohibit the introduction of new matter prior to filing the application. Such a narrow reading would prohibit continuation-in-part applications. The Code of Federal Regulations allows for continuation-in-part applications including new matter. 37 CFR 1.52(b)(2) specifically provides that "[a] continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application..."⁴ Rather, 35 U.S.C. 132 prohibits the introduction of new matter during the examination of the case (i.e., during prosecution). A careful reading of all of 35 U.S.C. 132(a) reveals that:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof...if, after receiving such notice, applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Clearly, 35 U.S.C. 132 only prohibits the introduction of new matter "if, after receiving such notice, applicant persists in his claim for a patent, with or without amendment..."

Applicant believes that the objections to the Specification are overcome for all the reasons provided above.

³ Office Action, ¶4, lines 1-7.

⁴ See also, MPEP §201.06(c)

The Office Action also provides that the abstract of the disclosure is objected to because it is too long. A new ABSTRACT is attached hereto as a separate sheet. No new matter is added. The objection to the Abstract is overcome.

The Examiner also discussed the claim of priority in the Office Action. The Office Action provides that

the claimed invention of claims 26-34, 46-57 and newly added claims 58-71 are not supported by the disclosure of the parent application 07/973,237 filed on 11/09/1992. Accordingly the claimed invention of claims 26-34, 46-57 and newly added claims 58-71 are not supported by the disclosures of European Patent Application EP89114386.9 filed on 08/03/1989, and the international application PCT/US90/03282 filed on 06/07/1990.⁵

Applicant is uncertain what the Examiner is attempting to prove in making this statement, or why the Examiner picked these two of the many applications in the priority chain. There is no requirement that a claim find complete support from a preceding application in order to claim priority to that application. The Applicant maintains that the present claims find complete support in the applications listed in the claim to priority.

The Office Action further provides that:

as best understood by the examiner, the claimed invention of claims 26-31 has the effective filing date of 07/06/1992 which is the filing date of the parent application 07/910,865. The claimed invention of claims 32-34, 46-71 has the effective filing date of 08/04/1989 which is the filing date of the parent application 07/389,727.

In the future, if any new claims are added it is applicant's responsibility to state the effective filing date of each claim and how each claim is supported by the parent applications.⁶

Applicant has not investigated the Examiner's understanding of the effective filing date of the various claims and therefore can neither confirm nor deny the Examiner's understanding. However, with respect to the "applicant's responsibility to state the effective filing date of each claim", Applicant is unaware of such requirement and

⁵ Office Action, ¶16, lines 1-6.

⁶ Office Action, ¶16, lines 7-16.

respectfully requests the Examiner identify what portion of the U.S. Code, the Code of Federal Regulations, or the Manual of Patent Examining Procedure upon which he is relying.

Moving to the claim rejections, claims 26-34 and 46-71 are currently pending in the application. Claims 34 and 46-71 were rejected and claims 26-33 were allowed. By this amendment, claim 34 is amended, claims 72-74 are added and claims 46-71 are cancelled without prejudice to filing continuing/divisional applications. It is respectfully submitted that the pending claims define allowable subject matter.

Claim 34 stands rejected under 35 U.S.C. §112, second paragraph. The Office Action further provides that claim 34 would be allowable if rewritten or amended to overcome the §112 rejection. Claim 34 is amended, changing the feature "the received test signal" to "the received transmission signal" consistent with the remainder of the claim. Applicant submits that the §112 rejection of claim 34 has been overcome and claim 34 therefore defines allowable subject matter. New claims 72-74, depend from claim 34, recite additional features thereto and are allowable therefore.

Claims 46-71 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 5,070,536. Claims 46-71 are cancelled without prejudice to filing a continuing application.

In view of the foregoing, it is respectfully submitted that the pending claims define allowable subject matter. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees to Deposit Account No. 13-0017.

Dated: June 28, 2005

Respectfully submitted,


Jonathan M. Rushman
Reg. No. 55,870

McAndrews, Held & Malloy, Ltd.
500 West Madison Street
34th Floor
Chicago, IL 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100